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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,209	11/19/2003	Jochen Heinz	5083-39	6012
27799	7590	02/24/2005	EXAMINER	
COHEN, PONTANI, LIEBERMAN & PAVANE			NASH, BRIAN D	
551 FIFTH AVENUE			ART UNIT	
SUITE 1210			PAPER NUMBER	
NEW YORK, NY 10176			3721	

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/717,209

**Applicant(s)**

HEINZ, JOCHEN

**Examiner**

Brian Nash

**Art Unit**

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) 34-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30, 32, 38-43 and 45-47 is/are rejected.
- 7) ☒ Claim(s) 31, 33 and 44 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/15/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Examiner's Comments***

1. This action is in response to applicant's election received 14 January 2005. Applicant elected Group I, claims 1-33 and 38-47, drawn to a method of manufacturing or handling an object. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. The pending claims remain 1-47. Claims 34-37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Drawings***

4. The drawings in this application are objected to because they are informal. The informal drawings filed in this application are acceptable for examination purposes. When the application is allowed, applicant will be required to submit new formal drawings.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is no antecedent basis for “the mold” in claim 8.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-8, 12-13, 17-25, 27-29 and 46-47 are rejected under 35 U.S.C. 102(b) as being anticipated by US 6,250,052 to Porfano et al. Porfano et al disclose the same invention including a method of manufacturing and handling a substantially pure object (such as a syringe barrel) comprising molding the object (12) and shielding the object from the environment by substantially enveloping it while still in the mold and placing it in a bell-shaped housing (Fig. 5) having clean and filtered air during its removal from the mold, i.e the objects are transferred from the mold to into an environmentally controlled area (column 3, lines 47-60) and conduction further processing such as siliconizing, assembling more components, and packaging (column 10, lines 54-57, Fig. 11). Porfano et al also disclose removing the object before cooling is complete (column 10, lines 51-55), i.e. in a generally soft or semi-molten state.

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The examiner notes that process steps such as “shielding from the environment”, “during removal of” and “conducted using a low starting speed”, while not indefinite, have been interpreted in the broadest sense.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 9-11, 14-16, 26, 30, 32, 38-43 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,250,052 to Porfano et al in view of US 5,141,430 to Maus et al. As discussed above, Porfano et al disclose the invention substantially as claimed, but do not show the molded object removed by a robotic machine having grippers or via fluid conveyed through nozzles. However, Maus et al teach an apparatus that molds and then removes the object via nozzles (15) through which air is channeled (column 4, lines 10-25 and column 7, line 67 to column 8, line 10). Maus et al further disclose that it is well known in the art to remove molded objects via mechanical grippers, i.e. robotic arms.

It would have been obvious to one having ordinary skill in the art to have combined the process of Porfano et al with the well known practice of either ejecting molded objects via channeled air or using grippers to mechanically remove the objects since either method yield the same result.

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***Allowable Subject Matter***

11. Claim 31, 33 and 44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ryder, Weiler et al, and Reilly et al are cited to show related references.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Nash whose telephone number is 571-272-4465. The examiner can normally be reached on Monday – Thursday from 8 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached at 571-272-4467.

The official fax number for this Group is: 703-872-9306

Brian Nash  
17 February 2005

A handwritten signature in black ink, appearing to read 'Rinaldi I. Rada', with a stylized, flowing script.

**Rinaldi I. Rada**  
**Supervisory Patent Examiner**  
**Group 3700**